

REMARKS

I. Summary of the Office Action and this Reply

Claims 1, 3, 6, 8, 9, 11 and 14-31 are pending in the application. The Examiner has rejected claims 21-24 under 35 U.S.C. '103(a), asserting obviousness based on U.S. Patent No. 5,263,134 to Paal et al. ("Paal") in view of U.S. Patent No. 5,634,064 to Warnock ("Warnock"). The Examiner has rejected claims 1, 3, 6, 11, 15, 16, 18-20 and 25-31 under 35 U.S.C. '103(a), asserting obviousness based on Paal in view of U.S. Patent No. 5,819,301 to Rowe ("Rowe") and Warnock. The Examiner has rejected claims 8 and 9 under 35 U.S.C. '103(a), asserting obviousness based on Paal, Rowe and Warnock in view of U.S. Patent No. 5,717,869 to Moran et al. ("Moran"). The Examiner has rejected claims 14 and 17 under 35 U.S.C. '103(a), asserting obviousness over Paal, Rowe and Warnock in view of U.S. Patent No. 5,553,225 to Perry ("Perry"). The Examiner has objected to claim 16.

In this Reply, claim 16 is amended. No new matter is added (see e.g. Figure 3).

II. Discussion

Claims 1, 3, 6, 8, 9 and 14

With respect to claim 1, a display window of a certain (e.g. 2"x3") size is required. Resizing of the slider superimposed over an image results in display of a corresponding portion of the image in the display window of the certain size. No matter the scope of the slider, the selected portion is scaled to fill the display window of the certain size, which results in enlargement of the selected portion of

the image. This is neither taught nor suggested by any of the cited art. The thumbnail window disclosed by Rowe shows in a first page only a reduced scale image of a portion of a second page, and has no relation to a slider or selected image portion. Further, the zoom function of Warnock has no relation to a slider, as claimed, and in an event discloses only that an item may be enlarged, but not that any selected portion of any scope may be enlarged to fit in a display window of a fixed size. In any event, there is no motivation to combine the teachings of Paal, Rowe or Warnock. The U.S. Court of Appeals for the Federal Circuit has considered the issue of finding motivation and stated that a finding of motivation "must be based on objective evidence of record" and that:

[an] Examiner's conclusory statements . . . do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." *In re Sang-Su Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002).

Further, the Federal Circuit clarified that conclusory statements asserting motivation that are based on "common knowledge and common sense" are not sufficient to fulfill the Board's obligation to develop an evidentiary basis for its findings. *Id.* There is no objective evidence of record, particularly in Paal, Rowe, Warnock and/or Moran (and particularly for the four-way obviousness rejection of claims 8 and 9), providing the asserted motivation.

For at least these reasons, reconsideration and withdrawal of the rejections of claims 1, 3, 6, 8, 9 and 14 are requested respectfully.

Claims 11, 18-20, 25-28 and 31

Claim 11 depends from claim 1 and is likewise believed patentable. Further, claim 11 expressly requires a second slider in addition to the first slider, both of

which are superimposed over an image. These two distinct sliders together define a selected portion of an image at their intersection. Paal discloses only a single view area. None of the cited art discloses two distinct sliders. The Examiner is reminded of the requirement of 37 CFR §1.104(c)(2) to identify the particular part of a reference that is relied upon, and is invited to identify with specificity any portion of Paal believed to disclose a first slider and a second slider.

Claims 25-28 and 31 depend from claim 11 and are likewise patentable. In addition, claim 25 requires that the first slider is translatable relative to an image along only one axis. Similarly, claim 26 requires that the first slider is resizable along only one axis. This is clearly distinct from the cited art, particularly Paal, which discloses a single view area that is translatable both horizontally and vertically, which is distinct from Paal. Claims 27 and 28 include similar recitations with respect to a second slider.

Further, claim 31 recites that there are both a first slider that is translatable and resizable only along a first axis, and a second slider that is translatable and resizable only along a second axis orthogonal to the first axis. This is neither taught nor suggested by Paal. At most, Paal discloses that a single view area that is translatable and resizable both horizontally and vertically, and that may be operated in a certain mode to scroll in a single direction only. See Action, page 7; Paal, col. 11, lines 52-68 and col. 12, lines 1-3. However, there is no disclosure whatsoever of two separate, specially configured sliders, each capable of translation/resizing in a one of two orthogonal directions.

Claims 18-20 are patentable for at least similar reasons.

For at least these reasons, reconsideration and withdrawal of the rejections of claims 11, 18-20, 25-28 and 31 are requested respectfully.

Claims 15-17, 29 and 30

Claim 15 is believed patentable for reasons similar to those set forth above. Additionally, in accordance with the Examiner's comments in paragraph 3 of the Action, claim 16 has been amended to recite that the slider includes not only a first portion that is superimposed and translatable over an image, and corresponds to the scope of said image, but also a second portion that is positioned outside of and adjacent to the image (see Figure 3). This is neither taught nor suggested by any of the cited art.

For at least these additional reasons, reconsideration and withdrawal of the rejections of claims 15-17, 29 and 30 are requested respectfully.

Claims 21-24

Independent claims 21 and 23 are directed to a system and computer program product for displaying a user-selected portion of an image. The system/product displays portions of an image selected by a resizable slider. Regardless of the size of the selected portion, the selected portion is displayed in a display area of a certain fixed size. Accordingly, any resizing of that slider, and corresponding resizing of a selected portion of that image, results in display of the resized portion in a display area that does not change in size. Accordingly, the selected portion is scaled accordingly for display in the display area of a fixed size. This is neither taught nor suggested by Paal or Warnock. Further, the claim recites that any selected portion (as determined by the slider) may be displayed in the display area; in contrast, Warnock discloses only that a certain predefined portion

(e.g. the article text) may be displayed. In any event, there is no motivation in the objective evidence of record (see above) to combine the teachings of Paal and Warnock.


For at least these reasons, reconsideration and withdrawal of the rejections of claims 21-24 are requested respectfully.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe claims 1, 3, 6, 8, 9, 11 and 14-31 to be patentable and the application in condition for allowance. Applicants respectfully request issuance of a Notice of Allowance. If any issues remain, the undersigned requests a telephone interview prior to the issuance of an action.

Respectfully submitted,

Dated: July 6, 2004


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